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[REDACTED] EXAMINER

FISCHMANN, BRYAN R

[REDACTED] ART UNIT [REDACTED] PAPER NUMBER

3618

DATE MAILED: 08/20/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/779,183	ELLINGTON, ERIC
	Examiner	Art Unit
	Bryan Fischmann	3618

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 10 July 2003.

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-9, 11-14, 16 and 18-24 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1-9, 11-14, 16 and 18-24 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on 08 February 2001 is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on 27 February 2002 is: a) approved b) disapproved by the Examiner.
 If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

- 1) Certified copies of the priority documents have been received.
- 2) Certified copies of the priority documents have been received in Application No. _____.
- 3) Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
 a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) Notice of References Cited (PTO-892) 4) Interview Summary (PTO-413) Paper No(s). _____ .
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) Notice of Informal Patent Application (PTO-152)
 3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ . 6) Other: _____

Acknowledgments

1. The Amendment (paper 13) filed 7-10-2003 has been entered.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 1-9, 11-14, 16 and 18-24 are rejected under 35 USC 101 due to the following:

Claim 1 appears to positively recite "the user" in the penultimate line of the claim.

A "user" is non-statutory subject matter.

To overcome this rejection, the "user" should only be mentioned within functional language.

For example, the last lines of claim 1 could be functionally worded "the step board is capable of allowing a user to provide significant leverage in controlling the peripheral edges of the slide board", or other similar wording. The above phrase could also be reworded to delete the term "user" altogether, such as the following wording: "when in use, the step board is capable of allowing significant leverage to be applied to the peripheral edges of the slide board", or other similar wording.

See also the recitation of "a user" in claims 9, 18 and 19 and the recitation of "the user's feet" in claim 18.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-8 are rejected under 35 USC 112 2nd paragraph due to the following:

A) Claim 1 recites the limitation "the deck board" in the penultimate line of claim

1. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office Action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1, 2, 5-9, 11-13, 16, 18 and 21-23 are rejected under 35 U.S.C. 102(b) as being anticipated by Dodge, US Patent 5,580,077.

Dodge teaches an elevated deck (see comments below) snowboard for sliding over snow, comprising:

an elongated slide board (10) having a slide surface on a lower surface thereof (Figure 2);

an elongated step board (34) defining a deck on an upper surface thereof (Figure 2) which is capable of freely accommodating both feet of a user (lines 25-28 of column 3 of the corrected specification) and attached to an upper surface of the slide board in

spaced and substantially parallel relationship via a connecting assembly including a plurality of connecting members (40 - see also Figures 1 and 5 – see additionally comments below regarding the term “substantially parallel”);

the connecting assembly being disposed inwardly of the peripheral edges of the slide and step boards (Figure 1); and

the connecting assembly substantially preventing the slide board and step board from pivoting relative to each other in at least a lateral direction of the snowboard (see Figure 5 and lines 40 and 41 of column 4 of the corrected specification) where connected by said connecting members during use of the snowboard, such that the step board provides the user a significant leverage in controlling the peripheral edges of the slide board (lines 43-46 of column 4 of the corrected specification).

Regarding the claim 1 recitation of “an elongated step board...attached to an upper surface of the slide board in spaced and substantially parallel relationship”, and similar recitations in claims 9 and 18, note that reference number 40 passes through spacer 54, which “spaces”, or provides a “spaced relationship” between the step and slide boards. Note also that reference number 40 is a screw that is affixed to the step board of Dodge and is also threaded into the slide board of Dodge. Due to this, in order for the step board of Dodge to “pivot” about the slide board, presumably about the base of inverted mushroom shaped spacer 54, the screw 40 would also have to “rotate” about an axis perpendicular to the plane of the paper illustrating Figure 5 of Dodge, where the spacer 54 meets washer 44. This is not possible since the screw 44 is securely threaded into the slide board of Dodge, as also shown on Figure 5. Note also that the

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flat surface on the upper portion of the spacer 54, where step board 34 "rests" on the spaced washer 54 will restrict bending of the step board, as the spacer and step board must remain parallel in the vicinity of reference number 54, due to the flat surface of washer 54 and the clamping force provided by reference number 40.

Further note that the specification of Dodge is replete with errors and the Applicant should refer to the "corrected" specification at the rear of the patent. Also note that line 37 and 38 of column 4 of the corrected specification recites "...slight....convex bending of the snowboard...". Note that "slight bending" is not considered inconsistent with Applicant's recitation of "substantially parallel relationship" in claim 1 and similar recitations in claims 9 and 18, as each recitation allows some deviation from a "completely" parallel relationship.

Regarding the recitation of "elevated deck" snowboard in claims 1, 9 and 18, note that Webster's Collegiate Dictionary, 10th Edition, defines "elevated" as: "raised...above...other surface". Note that this definition is consistent with the snowboard of Dodge, as the "deck" (34) is elevated, or "raised" above the "other surface" (10), as well as the ground by the presence of reference number 54 (see Figure 5).

Regarding claims 2 and 13, see Figure 1 of Dodge.

Regarding claim 5, see line 25 of column 3 of the "corrected" specification of Dodge.

Regarding claims 6 and 21, see the comments regarding the term "substantially" in claim 1.

Regarding claims 7 and 11, note the cross-hatching for reference numbers 44 and 54 on Figure 5 of Dodge corresponds to metal, which is "substantially rigid". See Section 608 of the MPEP, where cross-hatching for Patent Applications and Patents is defined. Note also that screw 40 is substantially rigid.

Regarding claims 8 and 12, note that reference number 40 and to a lesser extent, reference number 54, have a "substantially tubular" shape.

Regarding claim 16, see Figures 1 and 5.

Regarding claims 22 and 23, see Figure 1 of Dodge.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 3 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dodge, US Patent 5,580,077, in view of Andrew, et al, US Patent 4,320,905.

The snowboard of Dodge fails to teach that the step board is greater in width than the slide board.

However, Andrew teaches a step board (19-21) that is appreciably wider than a slide board (12 – see Figures 1 and 2). A step board that is appreciably wider than a slide board is advantageous in that the wider step board allows additional room for a user's feet and bindings, which are often oriented at a substantial angle to the

longitudinal axis of the snowboards. Also, a wider step board will facilitate maneuvering of the snowboard.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize a step board that is wider than a slide board for the snowboard of Dodge, as taught by Andrew.

10. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dodge, US Patent 5,580,077, in view of Tinkler, US Patent 5,544,919.

The snowboard of Dodge fails to teach an engagement portion in the nose part.

However, Tinkler teaches an engagement portion (Figure 1) in the nose of a sportsboard. Although Tinkler illustrates the engagement portion on a skateboard, Tinkler recites on lines 20 and 21 of column 5 "...these concepts are equally applicable with other sportsboards, such as snowboards...". An engagement portion on the nose of a snowboard is advantageous in that it allows a user's foot to remain engaged with the board, while also allowing the user's foot to be located at a part of the board where there is large "leverage" on the board, which facilitates accomplishing "stunts" and maneuvering.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize an engagement portion on the nose portion of the snowboard of Dodge, as taught by Tinkler.

11. Claims 19, 20 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dodge, US Patent 5,580,077, in view of Andrew, et al, US Patent 4,320,905.

Dodge teaches an elevated deck snowboard (see comments below) for sliding over snow, comprising:

an elongated slide board (10) having a slide surface on a lower surface thereof;
an elongated step board (34) defining a deck on an upper surface thereof which freely accommodates both feet of a user (lines 25-28 of column 3 of the specification); and

a connecting assembly made of substantially non-compressible material (see comments below) connecting the step board to an upper surface of the slide board in spaced and substantially parallel relationship (see comments below), and to allow a substantially increased leverage for controlling the slide board by prohibiting at least lateral movement between portion of the slide and step boards where connected by the connecting assembly during use of the snowboard board (lines 43-46 of column 4 of the corrected specification), the connecting assembly being disposed at intermediate portions of the slide and step boards inwardly of peripheral edges of the slide and step boards (Figure 1).

The snowboard of Dodge fails to teach that the step board is greater in width than the slide board.

However, Andrew teaches a step board (19-21) that is appreciably wider than a slide board (12 – see Figures 1 and 2). A step board that is appreciably wider than a slide board is advantageous in that the wider step board allows additional room for a user's feet and bindings, which are often oriented at a substantial angle to the

longitudinal axis of the snowboards. Also, a wider step board will facilitate maneuvering of the snowboard.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize a step board that is wider than a slide board for the snowboard of Dodge, as taught by Andrew.

Regarding the claim 19 recitation of an "elevated deck" snowboard in the preamble, see the comments regarding the same recitation in claim 1.

Regarding the claim 19 recitation of "a connecting assembly made of substantially non-compressible material", note that the cross hatching of references numbers 44 and 54 on Figure 5 indicate that they are made of metal. See Section 608 of the MPEP. Note also that reference number 40 is a screw. The Examiner takes Official Notice that screws are generally made of metal. This may be confirmed by a visit to any hardware store. Metal is an advantageous material for a screw, as metal has high strength and many types of metal, such as steel, are relatively inexpensive.

Regarding the claim 19 recitation "the step board to an upper surface of the slide board in spaced and substantially parallel relationship", see the comments regarding a similar recitation in claim 1.

Regarding claim 20, see the comments in claim 1 regarding the term "substantially".

Regarding claim 24, see Figure 1 of Dodge.

Response to Applicant's Remarks (paper 14) and Examiner's Comments

12. The amendment (paper 14) resolved the claim objections made on the last Office Action (paper 13).

13. The amendments to claim 19 have caused a new grounds of rejection of claim 19 to be set forth. Therefore, the comments regarding claim 19 relative to Andrew on pages 10-12 of paper 14 are considered moot.

14. Applicant's arguments (paper 14) with respect to the 102 rejections made on the last Office Action of claims being anticipated by Dodge have been considered, but are for the most part moot, due to the amendments to the claims. Note that a good portion of the remarks on pages 9 and 10 regarding the Dodge reference pertains to new limitations such as the snowboard having an "elevated deck" and the prevention of "lateral pivoting movement".

However, the Examiner would like to address one comment on page 10 of paper 14 that is still considered pertinent as follows:

On page 10 the Applicant recites "the overall fastening assembly between Dodge's snowboard 10 and mounting plate 28, including the resilient pads 44 and elongate forward openings 38, is specifically required to permit the...snowboard to move...relatively to the mounting plate, regardless of any rigidity imparted by the threaded bolts 40 and spacers 54... Such movement is properly considered (as)...relative movement... is contrary to the plain meaning of the claim language". Note that this discussion is best understood to pertain to the claim 1 limitation of "...elongated step board... attached to an upper surface of the slide board in spaced and substantially

parallel relationship..." and similar recitations in other claims. The following is noted regarding this recitation and the above comments by Applicant:

1) First note that, as already mentioned in this Office Action, that lines 37-39 of the "corrected specification" of Dodge recite "The mounting plate 28 is preferably constructed to encourage slight controlled...bending of the snowboard 10 about its longitudinal axis...". As previously noted in this Office Action and the previous Office Action (paper 12), the recitation of "slight bending" in the corrected specification of Dodge is not considered to be inconsistent with the claim 1 limitation of the step board attached to the slide board in substantially parallel relationship (as paraphrased). Although Applicant would appear to disagree with this from the above comments, the above comments are not considered compelling in challenging this assertion.

2) Also, in an effort to determine what is and isn't "substantially parallel", it would be useful to quantify the term "substantial". Note that case law states that "substantial does not connote 'small' or 'meager' it includes high range of 'principally' or 'entirely'; in view of evidence in file wrapper, court is not willing to extend it below 49%". *E.W. Bliss Co. v. Cold Metal Process Co.* (DC Nohio) 122 USPQ 238. From this, one could reasonably infer that 49%, or say 50% to simplify matters, which would be 50% between horizontal and vertical, such that any slope of 1 (45% to horizontal) or less of the step board to the slide board would meet the limitation of "substantially parallel". Although a reasonable person might disagree that a board with a slope of 45 degrees at some point along the length of the board would be "substantially parallel" to a "horizontal board", the above case law illustrates that the use of the term "substantially"

does not necessarily imply only very minor deviations from that which follows the word "substantially".

3) Further note that Webster's Collegiate Dictionary, 10th Edition, defines "substantial" as: "being largely but not wholly that which is specified". This definition is seen consistent with the equation of the terms "slight bending" and "substantially parallel" by the Examiner.

4) Additionally note that the claims do not appear to explicitly specify whether the step and slide boards are "substantially parallel" when in use, or not in use. It is believed that there would be little, if any disagreement between the Examiner and the Applicant that the step and slide boards of Dodge are substantially parallel when not in use. While it is noted that the last several lines of claim 1 require that the step and slide board do not "pivot" relative to each other in a lateral direction while the snowboard is in use, the portion of claim 1 pertaining to the step and slide board being "substantially parallel" do not appear to be "tied" to the snowboard being in use.

5) Figure 1 shows the feet of a user are placed "outboard" of the four connecting members (4) that connect the step and slide boards. Due to this, unless the step board is made of a very high strength material, such as high tensile strength steel, it would appear that some noticeable deflection of the step board will occur, particularly if the snowboard is made of wood, which is a known snowboard material. It would appear that both Applicant's step board and the step board of Dodge will experience some deflection from a "true" horizontal position. Note also that the Instant Specification does not appear to specify the material of the step or slide boards.

Note also that when in use, the dynamic forces imparted on the slide board will cause the slide board to noticeably deflect, unless the slide board is also made of a very high strength material.

Note additionally that the above discussed "deflections" of the step and slide boards of Applicant will occur in opposite directions, such that these deflections will cause Applicant's step and slide boards to deflect toward each other and away from a parallel configuration.

15. Regarding the 103 rejection of claim 4 as being unpatentable over Dodge in view of Tinkler made on the last Office Action (paper 13) and repeated on this Office Action (paper 15), the Applicant recites "...persons skilled in the art would never consider the same to have been obvious because of the fundamental differences/incompatibilities between Tinkler's skateboard and Dodge's snowboard...With the skate board, a user may freely position his/her feet thereon during use...with Dodge's snowboard the user's feet are rigidly mounted to the snowboard via the mounting plate and bindings... Given this difference, there is no motivation to put Tinkler's engagement portion on Dodge's snowboard...Further, given that Dodge's snowboard...is significantly longer than the mounting plate 28, Tinkler's engagement portion would presumably be located at a nose part of Dodge's snowboard 10 to have an effect similar to that on Tinkler's skate board...This would be contrary to the claimed invention...".

Examiner's Comment – Regarding the first "point" relative to the snowboarder not having the freedom of movement of his feet that would be present for a skateboarder, the Examiner would generally agree that a snowboarder would likely have less freedom

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of movement of his feet relative to a skateboarder. However, given the teachings of Tinkler, if a snowboarder wanted to perform tricks utilizing the engagement portion of Tinkler, it would certainly be possible and within the skill level of a snowboarder to not utilize one of the bindings of Dodge and instead utilize the engagement portion of Tinkler.

Note also that Tinkler recites on lines 20 and 21 of column 5 "...these concepts are equally applicable with other sportsboards, such as snowboards...".

Regarding the second "point" relative to the location of the engagement portion, for the engagement portion to be most readily accessible on the snowboard of Dodge, it is considered almost certain that the engagement portion would be located on a forward portion of the step board and not on the slide board, as apparently asserted by Applicant above. Locating the engagement portion of Tinkler on the slide board would make "reaching" the engagement portion with a snowboarder's foot difficult and uncomfortable for the snowboarder. Locating the engagement portion of Tinkler on the forward portion of the step board of Dodge would still provide additional leverage to perform tricks and would allow the engagement portion to be easily "reached" with a snowboarder's foot, even though the length of the step board of Dodge is shorter than the length of the slide board which would somewhat, but not significantly limit leverage over what the leverage would be if the engagement portion were located on a step board of equal or greater length to a slide board.

16. The Examiner noted the Applicant's invitation to call on page 14 of paper 14 in the event the claims were not considered allowable by the Examiner. However, due to

the numerous differences in opinion between the Applicant and the Examiner as to the allowability of the claims, as set forth in this Office Action (paper 15), it is considered that these "numerous differences" are too great to be easily resolved by a phone call.

Conclusion

17. Applicant's amendment necessitated the new grounds of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

18. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- A) Hangi – teaches a ski with an elevated deck
- B) Breuer, et al – teaches an elevated deck for a sliding device

19. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Bryan Fischmann whose telephone number is (703) 306-5955. The examiner can normally be reached on Monday through Friday from 7:30 to 4:00.

If attempts to reach the Examiner by telephone are unsuccessful, the examiner's supervisor, Brian Johnson, can be reached on (703) 308-0885. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

Bryan Fischmann 8-18-3
BRYAN FISCHMANN
PATENT EXAMINER